

60,130-1108; 01MRA0212

What is the status of the claims, and in particular, claims 19 and 20? Second, the Examiner continues to reference Reiter in the body of the rejection of claims 1-6, 8-12, 14-17 and 21-25, however, Reiter is not referenced in the heading. Please clarify whether Reiter is relied upon. Third, please provide an argument for claim 8. Is the Examiner using the argument set forth relative to claims 5 and 6?

Claims 1-6, 8-11, 14-17, and 21-25 were rejected under §103 over Kapaan in view of Johnston, and in further view of Otto. The rejections of claims 7 and 13 also rely upon Otto now. Claim 1 requires that the bearing assembly includes an inner race engaging the shaft portion of the driven shaft. The Examiner cannot make the proposed combination because it would destroy the goal of the base reference, Kapaan, which requires the inner race to be supported by a central element that is, in turn, placed on a fixed shaft under axial load (see Abstract and columns 1 and 2 of Kapaan). Modifying the arrangement of Kapaan with the Otto "to have an inner race engaging the shaft so as to reduce the number of parts" would ruin the very purpose of Kapaan. Accordingly, all of the rejections are improper and must be withdrawn.

Regarding the rejection of claims 5 and 6, the Examiner argues that it would be obvious as a matter of engineering design to choose nylon for its known friction reducing properties, and now also adds that the motivation would be to reduce weight. However, this argument does not satisfy a *prima facie* case of obviousness because it does not provide the requisite motivation. The Examiner's citation of Leshin does not sidestep the Examiner's obligation to provide a motivation (see MPEP 2143.01). That is, there is no motivation provided in any of the references to modify the base reference of Kapaan to provide a polymer cage. The Examiner is using

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hindsight to make the rejection. Furthermore, a polymer cage in the application of Kapaan would not work. Specifically, a nylon cage would not be able to support the radial load exerted upon the cage by the wheel of Kapaan, which has a considerably greater radial load than a pinion shaft. Additionally, the cage does not have a rotating part in engagement with it, so why would one use a polymer case to reduce friction? This rejection cannot withstand appeal.

Applicant believes that no additional fees are necessary, however, the Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.

Respectfully submitted,  
**CARLSON, GASKEY & OLDS**

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**CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8**

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, fax number (703) 872-9306, on March 29, 2004.

William S. Gottschalk